REMARKS

Applicants are responding to the Final Office Action of October 26, 2007 and the Advisory Action Before the Filing of an Appeal Brief of November 21, 2007. Claims 55-58 were not been entered by the Examiner and are not being added by this response. Otherwise, applicants present the same remarks below as in the Amendment filed November 16, 2007.

It appears that the Examiner raised only one issue with regard to the Declaration of Dana Alexa Totir, Kirakodu S. Nanjundaswamy and Michael Pozin Under 37 C.F.R. § 1.131 and one issue regarding the arguments made in the prior amendment. The issue with regard to the Declaration was raised in paragraph 16 of the office action:

> 16. The declaration filed on 09/27/07 under 37 CFR 1.131 has been considered but is ineffective to overcome the Bowles et al '545 and Otterstedt et al. '138 references. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the aforementioned references. The declaration filed on 09/27/07 does not clearly state that the invention was either made, researched/developed or reduced to practice in USA, a NAFTA member country or a WTO member country as established in 37 CFR 1.131. See MPEP 715 Swearing Back of Reference — Affidavit or Declaration Under 37 CFR 1.131.

A Second Declaration of Dana Alexa Totir, Kirakodu S. Nanjundaswamy and Michael Pozin Under 37 C.F.R. § 1.131 is enclosed. The Declaration states in paragraph 1 the work described in the Declaration was conducted in the United States. It is otherwise the same as the prior Declaration.

The other issue was raised in paragraph 17 of the office action:

> 17. With respect to the Boczer et al. '597 reference, applicant's statement that "'Boczer potentially qualifies as prior art only under 35 USC 102(e)..." (see 09/27/07 amendment on page 11, 2nd full paragraph) is not a conclusive and unequivocal statement of ownership and does not seem to include appropriate terminology for overcoming the rejection. The Examiner does not understand that term "potentially" within the meaning of the recitation or in the context of applicant's arguments. The Examiner does know what is the meaning of the term "potentially" but is unsure why applicant made such a statement.

All applicants meant by "potentially" was that 35 U.S.C. § 102(e) is the only statutory provision under which Boczer possibly could qualify as prior art. In particular, 35 U.S.C. § 102(a) or 35 U.S.C. § 102(b) are not applicable because of Boczer's late publication date. But Boczer does

not qualify as prior art under 35 U.S.C. § 102(e) for purposes of 35 U.S.C. § 103(a) because Boczer was owned by the same company as the present application at the time the invention covered by the claims in the present application was made. See 35 U.S.C. § 103(c).

Applicants will run through the arguments that they previously presented again below. The "potentially" language that the Examiner found confusing has been removed.

Claims 1-5, 8-12, 14-24, 28, 31-35, 39-43, 45 and 46 are pending.

Claims 1-4, 8-12, 14, 17-24, 31-35, 39-43, 45, and 46 are rejected under 35 U.S.C. § 102(e) as being anticipated by Bowles et al., 2005/0191545 ("Bowles"). Claims 1-5, 8-12, 14, 31-35, 39-43, 45, and 46 are rejected under 35 U.S.C. § 102(e) as being anticipated by Otterstedt et al., 2004/0053138 ("Otterstedt"). Applicants request that the rejections be reconsidered and withdrawn for the following reasons.

A reference qualifies as prior art under 35 U.S.C. § 102(e) only if the application has a filing date that predates the date on which an invention covered by a particular claim was made. Specifically, 35 U.S.C. § 102(e) provides, in relevant part:

> A person shall be entitled to a patent unless-
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> *****
>
> (e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent....

The present application was filed on March 15, 2004. Bowles was filed on February 26, 2004, and Otterstedt was filed on September 12, 2003. A Second Declaration of Dana Alexa Totir, Kirakodu S. Nanjundaswamy and Michael Pozin under 37 C.F.R. § 1.131, submitted with this amendment, establishes that electrical chemical cells covered by claims 1-5, 8-12, 14-24, 28, 31-35, 39-43, 45, and 46 were made and used by applicants in the United States (see paragraph 1) prior to September 12, 2003. For the convenience of the Examiner, paragraph 3 of the Declaration is quoted below:

3. The laboratory notebook pages demonstrate that electrochemical cells covered by claims 1-5, 8-12, 14-24, 28, 31-35, and 39-43, and 45-46 were made and used prior to September 12, 2003.

(a) Some of the information on the notebook pages is highlighted for convenience. See in particular the highlighted information next to "Cell #1" on page 2489-110 and "Cell #2" on page 2489-111. The electrochemical cells were coin cell models that included a plastic housing, a cathode including "β-EMD" (β-electrolytic manganese dioxide) on a "primed Al" (aluminum) current collector. The aluminum current collector in turn was pressed on an "SS grid". SS is stainless steel, and the aluminum current collector thus was in contact with a second metal surface (the stainless steel) different from the surface of the aluminum current collector. The cells included a "Li" (lithium) anode and an electrolyte including "0.05 M" (page 2489-110) or "0.03 M" (page 2489-111) LiBOB." LiBOB is lithium bis(oxalato)borate. Thus, the electrochemical cells described on laboratory notebook pages 2489-110 and 2489-111 include all of the requirements of claims 1-2, 5, 8-12, 31-35, and 45-46.

(b) Laboratory notebook pages 2489-110 and 2489-111 refer to "LiBOB in TDE10" in the highlighted information next to "Cell #1" and "Cell #2". TDE10 is an internal name for an electrolyte that includes, among other ingredients, lithium trifluoromethanesulfonate. Thus, electrochemical cells on laboratory notebook pages 2489-110 and 2489-111 also include all of the requirements of claims 3 and 4.

(c) The aluminum cathode current collector used in the electrochemical cells on laboratory notebook pages 2489-110 and 2489-111 had a size of at least one dimension greater than 2 millimeters. Thus, the electrochemical cells on laboratory notebook pages 2489-110 and 2489-111 include all of the requirements of claims 14-16.

(d) The electrochemical cells on laboratory notebook pages 2489-110 and 2489-111 were designed to be discharged once and then discarded, and thus are primary electrochemical cells as opposed to secondary (rechargeable) electrochemical cells. Thus, the electrochemical cells on laboratory notebook pages 2489-110 and 2489-111 meet all of the requirements of claims 17-24, 28, and 39-43.

Thus, the invention (the electrochemical cells) covered by claims 1-5, 8-12, 14-24, 28, 31-35, 39-43, 45 and 46 were made prior to the filing dates of Bowles and Otterstedt. As a result, Bowles and Otterstedt do not qualify as prior art to those claims under 35 U.S.C. § 102(e).

Thus, the 35 U.S.C. § 102(e) rejections of claims 1-5, 8-12, 14, 17-24, 31-35, 39-43, 45, and 46 based on Bowles and Otterstedt should be withdrawn.

Claims 9-12, 21-24, and 28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bowles and/or Otterstedt and further in view of Amine et al., 2005/0019670 ("Amine"). Bowles and Otterstedt do not qualify as prior art to claims 9-12, 21-24, and 28 for the reasons explained above. These claims have not been rejected based on Amine alone. Thus, the 35 U.S.C. § 103(a) rejection of claims 9-12, 21-24, and 28 based on Bowles and/or Otterstedt and further in view of Amine should be withdrawn.

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bowles and/or Otterstedt and further in view of Boczer et al., 2006/0216597 ("Boczer"). Bowles and Otterstedt do not qualify as prior art to claim 5 for the reasons explained above. In addition, Boczer was owned by the same company as the present application at the time the invention covered by the claims in the present application were made. Therefore, under 35 U.S.C. § 103(c), Boczer does not qualify as prior art to the present application for purposes of 35 U.S.C. § 103(a). Thus, the 35 U.S.C. § 103(a) rejection of claim 5 should be withdrawn.

Claims 31-35, 39-43, 45, and 46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bowles in view of Amine. Bowles does not qualify as prior art to claims 31-35, 39-43, 45, and 46 for the reasons explained above. These claims have not been rejected based on Amine alone. Thus, the 35 U.S.C. § 103(a) rejection of claims 31-35, 39-43, 45, and 46 based on Bowles and Amine should be withdrawn.

Claims 31-35, 39-43, 45, and-46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Otterstedt in view of Amine. Otterstedt does not qualify as prior art to claims 31-35, 39-43, 45, and 46 for the reasons explained above. These claims have not been rejected based on Amine alone. Thus, the 35 U.S.C. § 103(a) rejection of claims 31-35, 39-43, 45, and 46 based on Otterstedt and Amine should be withdrawn.

Claims 1-5, 8-12, 17-24, 28-35, 39-43, 45, and 46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Boczer in view of Amine. Claims 29 and 30 have been withdrawn. Boczer does not qualify as prior art to the present application for purposes of 35 U.S.C. § 103(a) for the reasons explained above. Claims 1-5, 8-12, 17-24, 28, 31-35, 39-43, 45, and 46 have not

been rejected based on Amine alone. Thus, the 35 U.S.C. § 103(a) rejection of these claims based on Boczer and Amine should be withdrawn.

Claims 1-5, 8-12, 24, 28-35, 39-43, 45, and 46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Boczer in view of Wietelmann et al., U.S. 6,506,516 ("Wietelmann"). Claims 29 and 30 have been withdrawn. Boczer does not qualify as prior art to the present application for purposes of 35 U.S.C. § 103(a) for the reasons explained above. Claims 1-5, 8-12, 17-24, 28, 31-35, 39-43, 45, and 46 have not been rejected based on Wietelmann alone. Thus, the 35 U.S.C. § 103(a) rejection of these claims based on Boczer and Wietelmann should be withdrawn.

Finally, claims 14-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bowles and/or Otterstedt in view of Amine and/or Boczer in view of Wietelmann and Krause et al., U.S. 5,691,081 ("Krause"). Bowles and Otterstedt do not qualify as prior art to these claims for the reasons explained above. Boczer does not qualify as prior art to the present application for purposes of 35 U.S.C. § 103(a) for the reasons explained above. The claims have not been rejected based on Amine, Wietelmann, and/or Krause alone. Thus, the 35 U.S.C. § 103(a) rejection based on the above combinations should be withdrawn.

Applicants submit that the claims are in condition for allowance and such action is respectfully requested.

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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